

REMARKS/ARGUMENTS

This paper is responsive to the Final Office Action mailed August 18, 2009. Claims 20-49 were pending before submission of this paper. Claims 20, 27-28, 32, 38 and 44 have been amended. Support for all amended claims can be found in the specification, and no new matter has been added by these amendments. Reconsideration of the claims in view of the amendments and the following remarks is respectfully requested.

I. EXAMINER INTERVIEW

A telephone interview was conducted with Examiner Sereboff on October 7, 2009 at approximately 11:45 Eastern Time. The undersigned attorney represented Applicant in the interview. In the interview, the cited ZeBU software was discussed. In particular, the circumstances regarding Applicant's limited knowledge of the ZeBU software was discussed and the Examiner confirmed that he could not find anything in the cited references to indicate that the cited AIMSuite and ZeBU Net software were the same product or components of the same product and, therefore, that they likely could not be combined for the purposes of a rejection under 35 U.S.C. § 102. While no definite agreement was reached, the Examiner graciously indicated that, upon Applicant's filing of a response, the 102 rejection would be withdrawn. Applicant thanks the Examiner for his time during the interview and presents this Amendment in accordance with that conversation.

II. CLAIM REJECTIONS UNDER 35 U.S.C. § 101

Claims 32-37 stand rejected under 35 U.S.C. § 101 allegedly because the claimed invention is allegedly directed to non-statutory subject matter. Specifically, the Office Action at page 2 alleges that "the process steps in claims (32-37) are not tied to a machine nor do they execute a transformation" and, therefore, are not statutory under 35 U.S.C. § 101.

For the sole purpose of expediting prosecution, Applicant has amended claim 32 to recite that the method is performed "under the control of one or more computer systems

configured with executable instructions.” Thus, Applicant respectfully submits that claim 32 recites statutory subject matter under 35 U.S.C. § 101 at least because it is tied to a machine, namely, one or more computer systems.

Claims 33-37 depend from claim 32 and, therefore, inherit the statutory subject matter of claim 32. Therefore, Applicant respectfully requests withdrawal of the rejection of claims 32-37 under 35 U.S.C. § 101.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 112

Claims 38-44 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In particular, the Office Action at page 3 alleges that “claim 38 includes the limitation, ‘as perceived by a person using the desktop visual metaphor’” and that “the Examiner is unsure how the perceptions of a user can be quantified so that all users can understand what a ‘desktop visual metaphor’ may entail.”

As an initial matter, Applicant respectfully points out that claims 38-43 do not contain the phrase “as perceived by a person using the desktop visual metaphor.” Thus, Applicant submits that there is no issue with respect to 35 U.S.C. § 112, second paragraph, with these claims.

Claim 44, which previously did include the phrase “as perceived by a person using the desktop visual metaphor,” solely for the purpose of expediting prosecution, has been amended to recite “the desktop visual metaphor is a graphical user interface including navigational control elements that common to at least a subset of the modules.” Thus, Applicant respectfully submits that language at issue is no longer in the claim and, therefore, that the rejection under 35 U.S.C. § 112, second paragraph is now moot. Thus, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 112.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 4-7, 20-28, 32, 34 and 35 stand rejected under 35 U.S.C. § 102(b) based upon a public use or sale of the invention, ZeBU Corporation software, herein referred to as ZeBU. Applicant respectfully disagrees.

A. Claims 4-7 Are Not Pending in the Application

Applicant respectfully points out that claims 4-7 have been cancelled without prejudice in the response filed April 30, 2009. Thus, it appears that the inclusion of claims 4-7 was inadvertent and thus these claims are not addressed by this Amendment.

B. Independent Claim 20

1. The ZeBU References Cannot Be Relied Upon as Prior Art

The Office Action at pages 3-4 alleges rejects claims 4-7, 20-28, 34, and 35 because allegedly Applicant's invention was in public use or on sale at least one year prior to Applicant's effective filing date. In support of the position, the Examiner cites to several documents that describe ZeBU software (hereinafter ZeBU references), many of which coming from the Internet Archive Wayback Machine (hereinafter "Archive"). Applicant respectfully submits that at least a portion of these documents cannot be used to reject Applicant's claims. Specifically, "an electronic publication, including an on-line database or Internet publication, is considered to be a 'printed publication' within the meaning of 35 U.S.C. 102(a) and (b) *provided the publication was accessible to persons concerned with the art to which the document relates.*" M.P.E.P. 2128 (emphasis added). Applicant respectfully submits that the ZeBU references have not and likely cannot be shown to be accessible to persons concerned with the art to which the document relates.

As noted, for example, the ZeBU references were accessed using the Archive in order to show that Applicant's invention was publicly used or sold more than one year prior to the effective date of Applicant's application. See Office Action, pages 3-4, paragraphs 7-8. According to the Terms of Use of the Internet archive, attached hereto as Exhibit A, "the Archive does not...guarantee or warrant that the content available in the Collections is accurate,

complete, noninfringing, or legally accessible in your jurisdiction.” Exhibit A, page 2. Further, “the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections, that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected.” *Id.* Further, in the Frequently Asked Questions section of the Archive’s website (attached hereto as Exhibit B), the Archive specifies that it “was not designed for legal use.” Exhibit B, page 6. In the Legal Frequently Asked Questions portion of the Archive’s webpage (attached hereto as Exhibit C), the Archive, with respect to affidavits available from the Archive, notes that “the Internet Archive’s affidavit only affirms that the printed document is a true and correct copy of our records.” The Archive continues to state that “it remains your burden to convince the finder of fact what pages were up when.”

In other words, the Archive itself explicitly disclaims any notions that the site can be used to prove the accuracy of its content and warns that materials from the site should not be used for legal purposes. As a result, Applicant respectfully submits that materials from the site cannot be used because it has not been shown that the materials were “accessible to persons concerned with the art to which the document relates” as required by M.P.E.P. 2128.

In addition to the foregoing, even assuming *arguendo* that dates provided by the Archive are generally accurate, Applicant respectfully submits that the cited ZeBU references from the Archive include content that puts into question the accuracy of the materials and especially any dates during which the Archive states the materials were archived. In particular, Applicant notes that the ZeBU references from the Archive entitled *AIM Home Office System*, *Select Tech Posts Record 171% Growth in AIM QuickView? Utilization*, *AIM Intelligent Tele-Interview System*, *What’s New at ZeBU*, *ZeBU Solutions – AIMSuite Overview*, and *AIM Direct Marketing System (DMS)* all include a logo for the company Integrated Insurance Technologies Corporation (IIT). All of these references allegedly have an archived date in 2001, according to the Archive. However, IIT did not exist until at least late 2002, as evidenced, for example, by

information provided by the California Secretary of State website (attached hereto as Exhibit D). This discrepancy puts into doubt the dates alleged on the references from the Archive.

Therefore, unless the dates of the references from the Archive are authenticated or otherwise established as accurate, Applicant respectfully submits that for at least the aforementioned reasons, the references from the Archive cannot be used to reject claims 4-7, 20-28, 34, and 35 under 35 U.S.C. § 102(b).

2. A *Prima Facie* Case of Anticipation Has Not Been Made

To establish a *prima facie* case that a claim is anticipated under 35 U.S.C. §102, it must be established that each and every element of the claim is present in a single reference: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In the present rejection, the Office Action cites multiple documents which, as best understood by Applicant, describe at least two distinct pieces of software: (1) ZeBUNet (as described in ZeBulletin, April 2001) and (2) ZeBU AIMSuite (as described in ZeBU SEC Filing, ZeBU 08-2002, and other references). According to the Office Action on page 18 in the Response to Arguments section, multiple documents are cited “to show that the structure not found within the primary art reference.” The Office Action “suggests that before making future amendments, the Applicant reviews all the Applicant’s own in-use work” and asserts that “the Applicant’s invention was appears [sic] operational more than one year before the effective filing data [sic] of the instant application.”

As previously noted, even assuming *arguendo* that the Office Action’s general rationale for combining multiple references is proper, “to anticipate a combination, the combination in its entirety must be old.” *Worthington v. Southern New Jersey Newspapers, Inc.*, 167 U.S.P.Q. 598, 610 (D. N.J. 1970) (citing *Bristol v. Otis Elevator Co.*, 10 U.S.P.Q. 212 (3d Cir. 1931)) (emphasis added). Accordingly, “all elements of the invention must be found in a single device in the prior art in order to negative novelty.” *Worthington*, 167 U.S.P.Q. at 610 (emphasis added).

As with the previous rejection, in the present rejection, the Office Action at pages 3-4 cites to ZeBulletin, April 2001, for “at least one client coupled to the at least one server, the at least one client adapted to allow access to the web-based system” and to the following documents for the remaining elements of claim 20: ZeBU SEC filing; ZeBU 08-2002; ZeBU Solutions—AIMSuite Overview; and Secure Internet Access to Application Status, Policy Data, Agent and Company Data. The portion of the ZeBulletin, April 2001 reference cited in the Office Action, an article entitled “ZeBU Introduces ZeBU Net” is directed to the ZeBU Net product. The remaining references are directed to the ZeBU AIMSuite.

As previously noted, as best understood by Applicant from the disclosure of the cited references, the AIMSuit product does not include the ZeBU Net product. Applicant submits that, unless the products operate together as a single device (e.g., as two separate programs that operate together using the same set of data), which the Office Action has not shown to be the case and which does not appear to be the case based on a review of the cited references, then a reference that describes one product cannot provide structure missing from another reference that describes another product.

The Office Action at page 20 in the Response to Arguments section analogizes the use of multiple references in this case to a situation where three different brochures are used to show features in the same car. Applicant does not dispute that the combination of three brochures to show features in the same car may be a proper combination of references. However, the rejection in the Office Action does not do this. On the contrary, continuing the Office Action’s analogy, the present rejection is akin to citing three brochures to describe two different cars. Specifically, as discussed during the aforementioned interview, the Office Action uses multiple references to show features allegedly present in at least two distinct pieces of software. As discussed above, unless the two distinct pieces of software work together in a manner that would anticipate the claims, which the Office Action has not demonstrated to be the case, then the references cannot be combined in the manner asserted in the Office Action.

Moreover, the Office Action does not allege that either of the ZeBU AIMSuite or the ZeBU Net products individually anticipate Applicant’s claim 20 (or work together to

anticipate claim 20), and, therefore, a *prima facie* case of anticipation has not been made with respect to either reference.

3. The Cited References, Even if Combined, Do Not Anticipate Claim 20

In addition to the foregoing, it is also further submitted that, as best understood from the above references, the ZeBU AIMSuite and ZeBU Net products do not anticipate Applicant's claims, even assuming *arguendo* that the two products were combined. For example, claim 20 recites "a web-based system" that employs "a desktop visual metaphor." The Office Action at page 4 asserts that this limitation is disclosed by a reference entitled ZeBU Solutions—AIMSuite Overview (hereinafter ZeBU Solutions) and by the components of the AIMSuite on pages 91-92¹ of Zebu's SEC filing (hereinafter "SEC filing"). Applicant respectfully disagrees. ZeBU Solutions, for example, provides a general description of the components of the AIMSuite family of products. For instance, ZeBU Solutions describes that "AIM GA gives the general agency the first fully integrated Agency Management system to automate all back office functions." Also, "AIM DMS sets the standard for initiating an insurance application at any point-of-sale location then distributes it through the application process." and "AIM ITS accommodates the gathering of essential application data directly from applicants using a reflexive telephone interviewing process, while printing out the completed application." The last component described in ZeBU Solutions is AIM Home Office, which "is instrumental in reducing the time and business costs associated with the underwriting/decision making process." ZeBU Solutions, however, is completely silent regarding "a desktop visual metaphor" as recited in claim 20.

Likewise, page 91 of the SEC filing does not disclose a "desktop visual metaphor" but lists features of the AIM WEB QUICKVIEW, AIM AGENCY QUICKVIEW, and AIM CARRIER QUICKVIEW products. Included in the SEC filing on pages 91 is a description that AIM QUICKVIEW "displays all pending case data for numerous

¹ The SEC filing, as provided by the USPTO, is numbered differently in three places. From context, Applicant assumes that the numbering in the top-left corner of the pages was intended. Further, while the Office Action specifies page 90, because the Office Action specifies "components of the AIM Suite," which appear on pages 91-92, it is assumed that pages 91-92 were intended.

carriers[,]...tracks pending application cases[,]...prints policies on-site[, and]...retains policy data onsite.” Page 92 of the SEC filing describes that AIM GA is a “completely integrated and scalable agency management system, including plan administration and system administration integrated with a contact management system” and that AIM ITS is “insurance application tele-interview software with customizable interview template...integrated with AIM QuickView.” The SEC Filing on pages 91-92 does not list or describe a “desktop visual metaphor” as one of the features of any component of the AIMSuite or any description of a desktop whatsoever. Therefore, it is respectfully submitted that the 35 U.S.C. § 102 rejection of claim 20 should be withdrawn at least for this additional reason.

In addition to the foregoing, in response to previous arguments that the cited art do not show a desktop visual metaphor, as recited in claim 20, the Office Action in the Response to Arguments section of the Office Action at page 21 states that “the Examiner found this language to be broad and therefore not [sic] indefinite.” Thus, it appears that the Office Action merely disregards the elements pertaining to a “desktop visual metaphor.” Consequently, in order to clarify the “desktop visual metaphor,” Applicant has amended claim 20 to recite that “the desktop visual metaphor [includes] at least one graphical object that may be selected by a user in order to activate a corresponding module of said modules.” Applicant respectfully submits that this element is not disclosed by the cited references at least for reasons discussed above, namely, because the cited references do not show any desktop visual metaphor and, therefore, do not show this particular desktop visual metaphor. Therefore, for at least this additional reason, Applicant respectfully submits that claim 20 is allowable under 35 U.S.C. § 102 over the ZeBU products.

C. Dependent Claims 21-31

Claims 21-31 depend from claim 20 and, therefore, are allowable at least for depending on an allowable base claim. Further, Applicant respectfully submits that at least some of claims 21-31 are patentable for additional reasons. For example, claim 27 recites that “the workflow engine implements a plurality of workflows [of claim 23] comprising a plurality of tasks and subtasks of an insurance underwriting process executed in a predefined sequence.”

The Office Action at page 6 alleges that “the plurality of workflows compris[ing] at least one public workflow and at least one private workflow” is taught by ZeBU Hub and Web QuickView “where the predetermined sequence is whether you have a login or not.” Applicant respectfully submits that whether you have a login or not is not a sequence, but a condition. A condition is not a sequence. Further, claim 27 recites “a plurality of workflows” and that the workflows comprise “a plurality of tasks and subtasks of an insurance underwriting process.” Applicant respectfully submits that determining “whether you have a login or not” does not, as disclosed in the ZeBU Hub and Web QuickView references, include a plurality of tasks and/or subtasks of an insurance underwriting process, as recited in claim 27.

Amended claim 28 recites that “the plurality of workflows comprises at least one public workflow and at least one private workflow, said public workflow including inter-organizational transfer of workflow data and said private workflow excluding inter-organization transfer of workflow data.” The Office Action at page 6 alleges that “the plurality of workflows [comprising] at least one public workflow and at least one private workflow” is disclosed by the ZeBU HUB software in ZeBU Solutions because the software “provides...Web-enabled database applications that organize workflow, provide intracompany and intercompany connectivity.” In addition, the Office Action alleges that “the type of workflow represents non-functional descriptive information” and, therefore, apparently does not give the term any patentable weight.

Applicant notes that claim 28 has been amended to recite that “public workflow including inter-organizational transfer of workflow data and said private workflow excluding inter-organization transfer of workflow data.” Applicant respectfully submits that mere providing of intercompany and intracompany connectivity, as recited in the cited ZeBU literature, does not disclose “inter-organizational transfer of workflow data and said private workflow excluding inter-organization transfer of workflow data” and, even assuming arguingo that it did, mere connectivity does not include “a plurality of tasks and subtasks,” as recited by claim 28 through inheritance from claim 27. Therefore, for at least the foregoing reasons, Applicant respectfully submits that claims 27-28 are allowable under 35 U.S.C. § 103 at least

because the claims recite subject matter that is not disclosed, taught, or suggested, either individually or in combination, by the ZeBU references.

D. Independent Claim 32

Applicant respectfully submits that claim 32 is allowable at least for reasons similar to at least some of those discussed above. For instance, claim 32 is rejected by the Office Action on page 7 as allegedly anticipated by the same two apparently distinct pieces of software as used in the rejection of claim 20. Further, claim 32 recites a “desktop visual metaphor” that includes “at least one graphical object that may be selected by a user in order to activate a corresponding module of said modules.” For reasons similar to at least some of those discussed above, the cited references, even if combined, do not disclose this element. Therefore, Applicant respectfully submits that claim 32 is allowable under 35 U.S.C. § 102 over the cited ZeBU references.

E. Dependent Claims 34-35

Claims 34-35 depend from claim 32 and, therefore, Applicant respectfully submits that claims 34-35 are allowable at least because they depend from an allowable claim. In addition, Applicant respectfully submits that claims 34-35 independently recite patentable subject matter. For instance, claim 34 recites “receiving a request to create a case through the desktop visual metaphor.” Claim 35 recites “receiving a request to track the case through the desktop visual metaphor.” As discussed above, the cited ZeBU references do not disclose the desktop visual metaphor as recited in claim 32. Therefore, the ZeBU references do not disclose these elements of claims 34 and 35 which involve the desktop visual metaphor recited in claim 32. Therefore, for at least these additional reasons, Applicant respectfully submits that claims 34 and 34 are allowable under 35 U.S.C. § 102 over the cited ZeBU references.

V. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 29-31, 32, 36, 38-42 and 44 stand rejected under 35 U.S.C. § 103(a) as being obvious over ZeBU, in view of Allport, (US 2001/0030644). Applicant respectfully disagrees.

With respect to claim 38, Applicant points out that claim 38 recites a computer-readable storage medium that includes “instructions for providing access to a plurality of modules of an application through the desktop visual metaphor, said modules operable to access the insurance-underwriting data and the desktop visual metaphor including at least one graphical object that may be selected by a user in order to activate a corresponding module of said modules.” Therefore, for at least reasons similar to at least some of those discussed above, this element is not disclosed, taught, or suggested by the ZeBU references, either individually or in combination. Further, Applicant respectfully submits that the Allport reference does not make up for the deficiencies of the ZeBU references at least because the reference is not directed to insurance underwriting, but to “methods...whereby multiple users can swap a controller of consumer devices between themselves frequently, whilst each retains the ability to reinstate their own customized controller interface.” As best understood by Applicant, the controllers of Allport are unrelated to insurance underwriting.

With respect to claim 32, the Office Action does not provide any reasoning why claim 32 would be rejected under 35 U.S.C. § 103. Thus, it appears that claim 32 was inadvertently included in the heading for the rejection in the Office Action at page 8 and, accordingly, Applicant does not address the rejection herein other than to point out, at least for reasons discussed above, that Allport does not make up for the deficiencies of the ZeBU references to disclose, teach, or suggest all elements of the claim.

With respect to claims 29-31, 33, 39-42, and 44, these claims all depend from one of claims 20, 32, or 38 and, therefore, these claims are allowable at least because they depend from an independent claim. In addition, Applicant additionally submits that these claims independently recite patentable subject matter that is not disclosed, taught, or suggested by the ZeBU references or Allport, either individually or in combination. Therefore, Applicant respectfully submits that these claims are allowable under 35 U.S.C. § 103 over the ZeBU references in view of Allport.

VI. Amendment To The Claims

Unless otherwise specified or addressed in the remarks section, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter. In addition, by focusing on specific claims and claim elements in the discussion above, Applicant does not imply that other claim elements are disclosed or suggested by the references. In addition, any characterizations of claims and/or cited art are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by another prosecution. Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present disclosure.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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